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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,666	04/11/2001	Tomoaki Aihara	P/1878-169	1818

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EXAMINER

NGUYEN, JIMMY

ART UNIT

PAPER NUMBER

2829

DATE MAILED: 08/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/832,666

Applicant(s)

AIHARA, TOMOAKI

Examiner

Jimmy Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 5/9/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 - 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### Response to Argument

1. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, by combining two references, Zamborelli will be able to solve the problem as indicated by the applicant in the back ground of the invention which is improve the speed to transmit the signal from the tester to the device under test under broader frequency (low, mid and high band frequency (Zammborelli, column 6 and 7).

Further, the applicant argues that the probe of the '051 patent is a different device than the tester that is the subject of the invention. The probe of '051 patent is a probe for an oscilloscope for testing outputs, while the tester of the present invention provides a signal to the inputs of dut (page 7 of the remark). The examiner is disagreeing. According to figure 1 of the '051 patent the signal is being transmitted in both way, one from the tester to dut and the other is from the dut send back to the tester. The signal is being communicated in both directions, therefore, it is going to direct the signal from the tester of the input dut at some point (as indicated in column 4 line 1- 6, the probe apparatus is **connected to an appropriat circuit contact point**).

Applicant's arguments filed 5/9/03 have been fully considered but they are not persuasive, therefore, this final is made.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 – 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art (figs 1 –3) in view of Zamborelli (US 5172051).

**As to claims 1, 7, 14, 21,** The admitted prior art (figs 1 – 3) disclose an inspection method and apparatus for simultaneously inspecting a plurality of semiconductor devices (64) each having a terminal (65) for an input signal, comprising the steps of.

Preparing a driver (62) for outputting a signal to be used for inspection;

Connecting an output terminal of driver (62) to a branching point (66b).

However, the admitted prior art is silent on connecting each of terminals of the semiconductor devices and the branching point through a current limiting element and a capacitor connected in parallel to current limiting element ; and

Outputting a signal from driver toward branching point.

On the other hand, Zamborelli disclose (fig 4) connection each of terminals of the semiconductor devices (104) and the branching point through a current limiting element (Rc) and a capacitor (Cc) connected in parallel to current limiting element (Rc); and

Outputting a signal (150) from driver toward branching point.

It would have been obvious to one having an ordinary skill in the art at time of the invention was made to modify the admitted prior art and using the probe tip assembly (101 with a RC parallel) for the purpose of reducing in stray capacitance and increasing the probe bandwidth (COLUMN 4 LINE 49 –51)

**As to claims 2, 8, 16, 19, 23, 26,** Zamborelli disclose the inspection method further comprise wherein a resistor (Rc or Rt) is used as current limiting element.

**As to claim 13,** The admitted prior art must (in the obvious way) provide the external clock ( CLOCK) is supplied to the second terminals through the second driver (in order the to activate the chips

**As to claims 15, 22,** Zamborelli disclose the current limiting elements ( $R_c$ ) and the capacitors ( $C_c$ ) are provided in a probe card (a probe tip in this case) or a test board for connecting semiconductor device (104) to be inspected to a tester (150).

**As to claims 3 - 6, 9 – 12, 17, 18, 20, 24, 25, 27 – 29,** Zamborelli discloses the claimed invention except for the value of resistor and capacitor. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use appropriate values for resistors, capacitors, and frequency given the device application since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

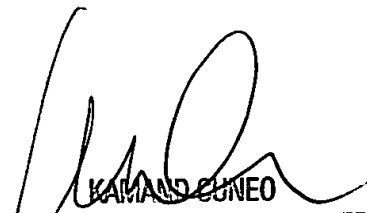
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy Nguyen at (703) 306-5858. Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4900.

JN.  
July 16, 2003



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